



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,600	09/02/1999	SHINICHI KANEMATSU	35.C13795	4211

5514 7590 10/08/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

JONES, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 10/08/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,600

Applicant(s)

KANEMATSU, SHINICHI

Examiner

David L Jones

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "134" and "135" have both been used to designate the printer (pg. 15, line 20). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "821" and "822" have both been used to designate error screen message (Fig. 60). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "398" has been used to designate both "set" and "cancel". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show items 354 (pg. 48, line 27), 661 (pg. 62, line 26) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required

Art Unit: 2622

in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 124, 130, 131, 332, 336, 337, 402, 403, 382, 383, 394, 398, 414, 415, 413, 427, 472, 494, 495, 496, 497, 524, 525, 526, 527, 533, 534, 535, 536, 552-554, 557-559, 562-564, 566, 568-570, 593-595, 603-607, 673-676, 651-655, 657, 658, 705, 728, 761-764, 848, S937, 875, 876, 913. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms, which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: Page 29, line 19, image bus 1120; "Database" as listed on page 55, line 9 has no reference in the drawings; Fig. 28, lists item 427 but listed in spec as 327 page 53, line 22; Page 57, line 16, paper size list shows item 611. The specification is difficult to follow throughout, applicant is advised to revise carefully, but reminded that no new matter may be entered.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 6, 7, 11, 12, 16, 17, 21, 22, 26, 27, 31, 32, 36, 37 rejected under 35 U.S.C. 102(e) as being anticipated by Ota et al. U.S. Patent 6,163,383.

Regarding claim 1, Ota et al. discloses an apparatus, which performs a service in association with a different apparatus accessible across a network, comprising: registration means for registering in advance predetermined information for a user who is authorized to use said apparatus (fig. 2, #161); input means for use by said user to enter said user information and a first operating instruction request for said different apparatus (fig. 2, #21A); first authentication means for employing said predetermined information registered by said registration means and said user information entered by said user at said input means to determine whether said user is an authorized user (fig. 1, #3); transmission means for, based on the results obtained by said authentication means, transmitting to said different apparatus a second operating instruction and said user information that are entered at said input means (fig. 2, #11); second authentication means for obtaining from said different apparatus the results of an authentication process, performed for said user information received from said transmission means, to determine whether said user is authorized to use said different apparatus (fig. 1, #6); and determination

Art Unit: 2622

means for employing the results obtained by said second authentication means to determine whether said user is to be permitted to use said service (fig. 1, #3).

Regarding claims 2, 7, 12, 17, 22, 27, 32, and 37, Ota et al. discloses an apparatus that wherein said registration information and said user information each includes at the least a user ID and a password (column 3, lines 45-50).

Regarding claim 6, Ota et al. discloses an apparatus that performs a service in cooperation with a different apparatus accessible across a network, comprising: registration means for registering, in advance, predetermined information for a user who is permitted to use said apparatus (fig. 2, #161); reception means for receiving user information and an operating instruction request for said apparatus, both of which are entered by a user at said different apparatus an said network (fig. 2, #21); authentication means for employing said information registered by said registration means and said user information received by said reception means to determine whether said user is an authorized user (fig. 1, #3); and determination means for employing the results obtained by said authentication means to determine whether said operating instruction request received by said reception means is to be accepted (fig. 1, #3).

Regarding claim 11, Ota et al. discloses a communication system wherein at least a first device performs a service in association with a second device accessible across a network, said first device comprising: first registration means for registering in advance predetermined information for a user who is authorized to use said first device (fig. 2, #161); input means for use by said user to enter said user information and an operating instruction request for said second device (fig. 2, #21A); first authentication means for employing said predetermined information registered by said first registration means and said user information entered by said

Art Unit: 2622

user at said input means to determine whether said user is an authorized user (fig. 1, #3); transmission means for, based on the results obtained by said first authentication means, transmitting to said second device said user information and said operating instruction that are entered at said input means (fig. 2, #11), and said second device comprising: second registration means for registering, in advance, predetermined information for a user who is permitted to use said second device (fig. 2, #161); reception means for receiving user information and an operating instruction request for said second device, both of which are entered by a user at said first device (fig. 2, #11); second authentication means for employing said information registered by said second registration means and said user information received by said reception means to determine whether said user is an authorized user (fig. 1, #6); and determination means for employing the results obtained by said second authentication means to determine whether said operating instruction request received by said reception means is to be accepted (fig. 1, #3).

Regarding claim 16, Ota et al. discloses a communication method whereby an apparatus performs a service in association with a different apparatus accessible across a network, comprising the steps of: employing a registration table in which user information entered by a user and predetermined information for a user who is permitted to use said apparatus are registered in advance, to determine whether said user is an authorized user (fig. 3B); based on the obtained results, transmitting to said different apparatus an operating instruction and said user information that are entered by said user (fig. 2, #11); obtaining from said different apparatus the results of an authentication process, performed for said user information that are transmitted, to determine whether said user is authorized to use said different apparatus (fig. 1, #6); and

Art Unit: 2622

employing the obtained results to determine whether said user is to be permitted to use said service (fig. 1, #3).

Regarding claim 21, Ota et al. discloses a communication method whereby an apparatus connected to a network performs a user authentication process, comprising the steps of: receiving, from a different apparatus on said network, user information and an operating instruction request for said apparatus (fig. 2, #4); employing a registration table in which said user information and predetermined information for a user who is permitted to use said apparatus are registered in advance, to determine whether said user is an authorized user (fig. 3B); and employing the obtained results to determine whether said received operating instruction request is to be accepted (fig. 2, #15).

Regarding claim 26, Ota et al. discloses a communication method whereby at least a first device and a second device mutually communicate with each other across a network and each perform a user authentication process, comprising: a determination step whereat said first device employs a registration table in which user information entered by a user and predetermined information for a user who is permitted to use said apparatus are registered in advance, to determine whether said user is an authorized user (fig. 3B); a transmission step where, based on the obtained results, said first device transmits to said second device an operating instruction request and said user information that are entered by said user (fig. 2, #11); a reception step whereat said second device receives said user information and said operating instruction request output at said transmission step (fig. 2, #11); a determination step whereat said second device employs a registration table in which said user information received at said reception step and predetermined information for a user who is permitted to use said apparatus are registered in

Art Unit: 2622

advance, to determine whether said user is an authorized user (fig. 2, #12); and an accepting step whereat said second device employs the obtained results to determine whether said operating instruction request received at said reception step is to be accepted (fig. 2, #15).

Regarding claim 31, Ota et al. discloses a storage medium (fig. 2, #10) on which is stored a computer program that is to be executed by the computer of an apparatus that performs a service in association with a different apparatus accessible across a network, said computer program comprising: a process for employing a registration table in which user information entered by a user and predetermined information for a user who is permitted to use said apparatus are registered in advance, to determine whether said user is an authorized user (fig. 3B); a process for, based on the obtained results, transmitting to said different apparatus an operating instruction and said user information that are entered by said user (fig. 2, #11); a process for obtaining from said different apparatus the results of an authentication process, performed for said user information that are transmitted, to determine again whether said user is authorized to use said different apparatus (fig. 1, #6); and a process for employing the obtained results to determine again whether said user is to be permitted to use said service (fig. 1, #3).

Regarding claim 36, Ota et al. discloses a storage medium (fig. 2, #10) on which is stored a computer program that is to be executed by the computer of an apparatus that performs a service in association with a different apparatus accessible across a network, said computer program comprising: a process for receiving, from a different apparatus on said network, user information and an operating instruction request for said apparatus (fig. 2, #14); a process for employing a registration table in which said user information and predetermined information for a user who is permitted to use said apparatus are registered in advance, to determine whether said

Art Unit: 2622

user is an authorized user (fig. 2, #15); and a process for employing the obtained results to determine whether said received operating instruction request is to be accepted (fig. 2, #151).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5, 8-10, 13-15, 18-20, 23-25, 28-30, 33-35, 38-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. as applied to claims 1, 2, 6, 7, 11, 12, 16, 17, 21, 22, 26, 27, 31, 32, 36, 37 above, and further in view of Nakai et al. U.S. Patent 5,946,457.

Regarding claims 3, 8, 13, 18, 23, 28, 33, 38 Ota et al. discloses a plurality of printers across a network, Ota et al. does not disclose a scanner or facsimile device or their uses or whether or not storage of files is capable, although he does disclose a database (fig. 2, #16). Whereas Nakai et al. discloses a plurality of scanners (fig. 11, #91-94) and a plurality of printers (fig. 11, #91-93, 95) wherein operating instructions allow for one device to utilize another device across the network, where scanner means for reading a document, wherein said operating instruction is an instruction for printing image data read by said scanner means using a printer function of said different apparatus. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize the system by Ota et al. on the system by Nakai et al., thereby creating a secure system to verify all users are authorized to access to devices

Art Unit: 2622

across the network and that to operate they must include operating instructions provide by operating software.

Regarding claims 4, 9, 14, 19, 24, 29, 34, 39 Ota et al. discloses a secure system whereby access to a device is controlled, but does not disclose a separate storage device. Whereas Nakai et al. discloses a plurality of memory in the scanners/printers (fig. 11, 91-94) and in the host computer (fig. 11, #96) which when as needed allows for storing of images, in a predetermined area, image data read by said scanner means using a storage function of said different apparatus (column 14, lines 13-19; column 23, 31-39). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize the system by Ota et al. on the system by Nakai et al., thereby allowing for secure storage as needed within the network and that to operate they must include operating instructions provide by operating software.

Regarding claims 5, 10, 15, 20, 25, 30 Ota et al. discloses a secure system whereby access to a device is controlled, but does not disclose a separate facsimile device. Whereas Nakai et al. discloses a facsimile device (fig. 11, #98; column 14, lines 38-47), where image data read by said scanner can be sent to another device using a facsimile transmission function of said different apparatus. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize the system by Ota et al. on the system by Nakai et al., thereby allowing for a secure environment in which to send a document across a telephone line and that to operate they must include operating instructions provide by operating software.

Art Unit: 2622

Conclusion

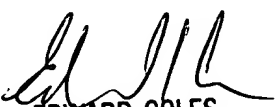
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Connors et al. U.S. Patent 5,627,658 discloses a plurality of multifunction devices each having a facsimile function that are connected together in a networking arrangement. Manchala et al. U.S. Patent 6,088,119 discloses a network is used for communication between the elements within the network; encryption and passwords may be used for security. Dziejewit et al. U.S. Patent 5,031,214 discloses a document authentication apparatus that provides document authentication and authenticity capability. Le Corre et al. U.S. Patent 5,555,307 discloses a device and process for securing the transmission of telecopies or faxes and a secured telecopy or fax unit having a security device. Nakamura et al. U.S. Patent 5,784,664 discloses a copier supervisory control system in which a plurality of copiers are connected to each other over a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (6:30am - 3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

dlj


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600